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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,597	07/28/2003	Alton W. Hezeltine	884.413US2	4627

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EXAMINER

CHUKWURAH, NATHANIEL C

ART UNIT PAPER NUMBER

3721

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/628,597

Applicant(s)

HEZELTINE, ALTON W.

Examiner

Nathaniel C. Chukwurah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,10,12, 14-16,21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 6-9,11,17-20,22 and 26-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/20/2006.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the amendment filed on 9/20/2006.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 12, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Pyatov (US 4,823,886).

With regard to claims 1 and 12, the reference of Pyatov discloses a tool (10) comprising: a body (12, 14) having a chamber (38); a piston (16) within the chamber (38); a nose as shown in Figure 1 having a channel (22); a pin (26) within the channel (22) and physically independent of the piston (34 striker); a propulsion element (16) coupled to the body to propel the piston (34) against the pin (26); and an inherent actuation element coupled to the propulsion element (16) to actuate the propulsion element. The channel of Pyatov's tool is dimensioned and capable of retaining a fastener the same way it is retaining the working tool, prior to actuation of the propulsion element.

With regard to claim 3, the piston (34) of the tool of Pyatov has more mass as shown in Figure 1, than the pin (26).

With regard to claim 14, the piston (34) of the tool of Pyatov has more mass as shown in Figure 1, than the pin (26).

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With regard to claim 21, the actuation element must inherently include a depressible member as in all power tools.

4. Claims 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Suher (US 5,417,294).

With regard to claim 23, the reference of Suher discloses a tool (10) comprising: a body (12) having a cylindrical chamber (30); a primary hammer (32) movable within the chamber (30); a nose (28a) coupled to the body (12) and having a channel (30 bore) capable of receiving a fastener; a secondary hammer, physically independent of the primary hammer (32), having a pin (T) movable within the channel (30) during installation; an air delivery infrastructure (valve, air) to propel the primary hammer (32) against the secondary hammer, to cause the pin (T) to strike a fastener; and an actuation element (20 trigger) coupled to the air delivery infrastructure (valve, air) to actuate the propulsion element (valve, air).

With regard to claim 24, the primary hammer (32) of the tool of Suher has more mass than the secondary hammer (T).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyatov in view of Tanaka (US 5,437,339).

With regard to claims 4 and 15, the tool of Pyatov discloses the claimed subject matter except

or at least one resilient bumper. The reference of Tanaka teaches resilient bumper (5) for absorbing the impulse force of the piston. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the tool of Pyatov providing a bumper in order to absorb the impulse force of the piston.

7. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyatov in view of Tanaka (US 5,437,339) as applies to claim 4 and further in view of McCloud (US 3,114,421).

With regard to claims 5 and 16, the modified tool of Pyatov lacks a tip adapter within the channel and having an interior bore within which the pin is movable. The reference of McCloud teaches a tip adapter (52) within the channel of the outer portion of the nose portion and having an interior bore as shown in Figure 1. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the tool Pyatov with the adapter including a bore as taught by the reference of McCloud in order to engage different tool bits.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pyatov in view of Obergfell et al. (US 3,858,781).

With regard to claim 10, the tool of Pyatov discloses the claimed subject matter except the actuation element's depressible member moving within the channel.

The reference of Obergfell teaches an actuation element (48) including a depressible member (100) for engaging the workpiece prior to nailing the workpiece. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the tool of Pyatov

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with depressible member moving within the nose channel as taught by Obergfell in order to prevent accidental actuation before the tool is engaged with the workpiece.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suher in view of in view of McCloud (US 3,114,421).

With regard to claim 25, the tool of Suher discloses the claimed subject matter but lacks a tip adapter within the channel and having an interior bore within which the pin is movable.

The reference of McCloud teaches a tip adapter (52) within the channel of the outer portion of the nose portion and having an interior bore as shown in Figure 1.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the tool Suher with the adapter including a bore as taught by the reference of McCloud in order to engage different tool bits.

#### *Allowable Subject Matter*

10. Claims 6-9, 11, 17-20, 22 and 26-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the tool comprises a vacuum element to couple to a vacuum generator wherein the nose comprises a passage to receive vacuum from the vacuum element, and wherein the tip adapter comprises a cylindrical wall having a hole to communicate with the passage to receive vacuum.

The art of record considered as a whole, lone or in combination, neither anticipates nor

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renders obvious a tool, wherein the tip adapter comprises an additional actuation element coupled to the propulsion element, wherein the propulsion element is to be actuated only if both the actuation element and the additional actuation element are moved.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the tool comprises a vacuum element to couple to a vacuum generator, wherein the vacuum element is coupled to the chamber to retract the piston when vacuum is applied to the vacuum element.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the propulsion element comprises a supply hose connection and a pilot hose connection to couple to a supply hose and to a pilot hose, respectively, wherein the supply hose connection is to provide vacuum when air within the pilot hose connection has greater than a predetermined pressure, and wherein the supply hose connection is to provide air pressure when air within the pilot hose connection has less than the predetermined pressure.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, further comprising a vacuum element to couple to a vacuum generator, wherein the nose comprises a passage coupled to the vacuum element to receive vacuum, and wherein the tip adapter comprises a cylindrical wall having a hole to communicate with the passage to receive vacuum.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the tip adapter comprises an additional actuation element coupled to the air delivery infrastructure, wherein the air delivery infrastructure is actuated only if both the actuation element and the additional actuation element are moved.

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The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, further comprising a vacuum element to couple to a vacuum generator, wherein the vacuum element is coupled to the chamber to retract the piston when vacuum is applied to the vacuum element.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the air delivery infrastructure comprises a supply hose connection and a pilot hose connection to couple to a supply hose and to a pilot hose, respectively, wherein the supply hose connection is to provide vacuum when air within the pilot hose connection has greater than a predetermined pressure, and wherein the supply hose connection is to provide air pressure when air within the pilot hose connection has less than the predetermined pressure.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, further comprising a vacuum element, wherein the nose comprises a passage coupled to the vacuum element to receive vacuum, and wherein the tip adapter comprises a cylindrical wall having a hole to communicate with the passage to receive vacuum.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the tip adapter comprises an additional actuation element coupled to the air delivery infrastructure, wherein the air delivery infrastructure is actuated only if both the actuation element and the additional actuation element are moved.

The art of record considered as a whole, lone or in combination, neither anticipates nor



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renders obvious a tool, further comprising a vacuum element to couple to a vacuum generator, wherein the vacuum element is coupled to the chamber to retract the primary hammer when vacuum is applied to the vacuum element.

The art of record considered as a whole, lone or in combination, neither anticipates nor renders obvious a tool, wherein the air delivery infrastructure comprises a supply hose connection and a pilot hose connection to couple to a supply hose and to a pilot hose, respectively, wherein the supply hose connection is to provide vacuum when air within the pilot hose connection has greater than a predetermined pressure, and wherein the supply hose connection is to provide air pressure when air within the pilot hose connection has less than the predetermined pressure.

#### ***Response to Arguments***

11. Applicant's arguments filed 9/20/2006 have been fully considered but they are not persuasive.

With respect to claims 1 and 12, applicant argues that the reference of Pyatov does not appear to have a channel dimensioned to retain a fastener until the propulsion element is actuated.

The Examiner contends that the nose channel of Pyatov's tool is capable of retaining a fastener the same way it is retaining the working tool, prior to actuation of the propulsion element.

The working tool flange and the tool holder are part of the support for working tool from falling out due to the weight of the working tool.

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In the case of a fastener, which is much more less in weight than the working tool, the channel is capable of retaining the fastener.

The reference of Pyatov is capable of disclosing a fastener if so desired.

With respect to claims 23 and 24, applicant argues that the reference of Suher does not appear to have a channel dimensioned to retain a fastener until the propulsion element is actuated.

The Examiner contends that the nose channel of Suher's tool is capable of retaining a fastener the same way it is retaining the working tool, prior to actuation of the propulsion element.

With respect to claims 4-5, 15-16 and 25, see response as set forth above, to applicant's argument regarding the nose channel dimensioned to retain a fastener.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

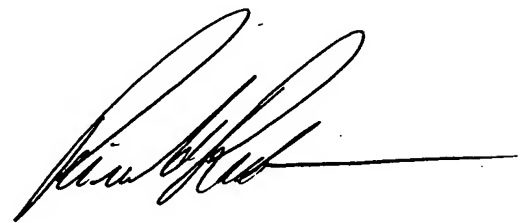
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

November 2, 2006.



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